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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,399	09/26/2006	Antoni Torrens Jover	284394US0PCT	3490
22850	7590	12/08/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	
			NOTIFICATION DATE	DELIVERY MODE
			12/08/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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### Office Action Summary

**Application No.**

10/566,399

**Applicant(s)**

TORRENS JOVER ET AL.

**Examiner**

Celia Chang

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election of Group I: Claims 7 and 15 and claims 1-6, 8-14, 16-21 reading on R<sup>6</sup>, R<sup>7</sup> and R<sup>8</sup> are H or alkyl in the reply filed on Sep. 24, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claims 7, 15 and claims 1-6, 8-14, 16-21 reading on R<sup>6</sup>, R<sup>7</sup> and R<sup>8</sup> are H or alkyl are prosecuted. Claims 22-23 and the remaining subject matter of claims 1-6, 8-14, 16-21 reading on R<sup>6</sup>, R<sup>7</sup> and R<sup>8</sup> are not H or alkyl are withdrawn from consideration per 37 CFR 1.142(b)

2. Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what does the term "medicament" mean. Is it a composition containing a therapeutically effective amount of a medicine? Or is it administration of a medicine to cause an effect in treating one of the disorders? The claims are considered hybrid claims containing multiple categories of invention i.e. both composition and method of use. The claims are confusing and indefinite as explained:

If the claims are drawn to pharmaceutical composition, how many are there? Please note that treatment of disease or disorder in current practice is pathology or symptom oriented. The effective process/composition of treating obesity would require decrease of food intake. Such a process/composition would be detrimental to the person who is anorexic or bulimic. In addition, for a composition to be effective in treating diabetes, a process/effective amount of lowering blood glucose (please note that treating diabetes or diabetic complication are different disorders) is needed; for treating cardiovascular disorder such as ischemic coronary disorder, an coronary vasodilating process/effective amount is needed; for treating epilepsy, an anticonvulsive process/effective amount is needed, etc. Therefore, it is unclear how many compositions or processes are encompassed by the claims. In addition, the claimed processes or

compositions are intended for accomplishing opposite effects such as treating obesity and bulimia at the same time which is incredible.

Further more, the claims also includes "propylaxis" which is self conflicting since for example if the composition is for "improvement" or "treatment" of a diagnosed disorder, there could not be any de novo prophylaxis efficacy.

3. Claims 1-2, 5-6, 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification while provided how to make the compounds or prima facie modification such compounds to its pharmaceutically addition salt with pharmaceutically acceptable acids, does not provide enablement for making unknown solvates. It is well recognized in the art that confusion may occur even among experts in so far as what constitutes a polymorph material. Seddon clearly described that in this century, with the advancement of the chemical art, there should never be any doubt about the chemical identity of a material. Therefore, if a solvate, a hydrate or a salt is made, one should clearly identify such material with its chemical identity.

It is further recognized by artisan in the field that material having identical chemical composition i.e. structural formula, may differ in solid forms, i.e. polymorph (Yu et al. p.122) and "solvates" of a compound, if existed are different chemical identities from the non-solvated material, and the identification of solvates must be evidenced by such data as TGA loss, H1 NMR spectroscopy, Karl Fischer titration etc. (Yu et al. p.122).

In addition, skilled person in the art is well aware of that the different chemical identities which are prepared by different processes, acquiring one does not offer any operability in possession of another. Braga et al. (p.3640) explicitly provided the state of the art understanding that in possession of a compound per se would be a nightmare to predict how many or what kind of a solvate it can form. Absent of explicit enabling teaching such as what solvents, temperature, concentration etc. a process for making compound per se does not offer any enablement for any solvate.

The specification described that the "prodrug" is the modification wherein "a moiety that will give rise to a pharmacologically *active* metabolite" of a compound. Please note that the "prodrug" of the claims are structural moieties. To qualify as a prodrug modification the relationship of inactive precursor being in vivo metabolically changed into an "active" compound as described must be provided. In the specification, no description or provision of which "prodrug" modification meets such prodrug requirement nor how can they be used i.e different dosage from administering/preparing an effective pharmaceutical composition. Without any guidelines, one having ordinary skill is offered mere language rather than enablement since among the whole prodrug literature no guidelines as to which one to pick or choose as to have any predictability of operability. The law requires that the specification itself to inform not for other to find out by themselves. In re Gardner 166 USPQ 138.

As a corollary to the above 2<sup>nd</sup> paragraph rejection, claims 19-21 are also rejected under 35 USC 112 first paragraph as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As it was delineated in section 2, the claims are drawn to different "effective" dosage for the specific disorder including opposite effects as well as for all CNS disorder, all cardiovascular disorder etc. which is incredible. For the time being there has not been evidenced that a single drug can be operable for all the disorders as claimed. In absence of any dosage information, the specification offered mere language rather than enablement.

4. Claims 1-21 are directed to the same invention as that of claim 22 of commonly assigned SN 10/565,979, especially guided by p.52 US2008/0119516 compounds 166-167 identical to compounds 5-6 of instant claim 15. The issue of priority under 35 U.S.C. 102(f) of this single invention must be resolved.

Please note that the copending application has a "different" inventive entity as the instant application.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter

2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

5. Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 22 in view of compounds 166-167 of copending Application No. 10/565,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because anticipatory species encompassed by the copending claims rendered the variation of the species by the generic teaching *prima facie* obvious.

The claims or the copending application included compounds 166-167 which anticipated the instant claims when one of R<sup>1</sup>-R<sup>4</sup> is OR<sup>8</sup> and R<sup>8</sup> is H or alkyl. Broadly, the generic claims or the copending application included that the OR<sup>8</sup> can be at other position on the phenyl ring as well as on the carbazolyl moiety (see p.62 claim 22 formula E, R<sup>E</sup> is optionally alkoxy). Therefore, overlapping subject matter fully embraced by the copending claims are being claimed in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*OACS/Chang  
Dec. 3, 2009*

*/Celia Chang/  
Primary Examiner  
Art Unit 1625*